



PATENT
Attorney Docket No.: 53470.003030

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/884,467 Confirmation No.: 9623
Applicant : Jeffrey A. BEDELL, et al.
Filed : June 7, 2004
Title : System and method for analyzing statistics in a reporting system
TC/Art Unit : 2171
Examiner: : W. Amsbury

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over four years ago on June 20, 2001. In 2003, an initial Office Action was issued, rejecting all 27 claims based either on U.S. Patent No. 6,115,693 to McDonough et al. ("McDonough") based on 35 U.S.C. § 102(e) or 35 U.S.C. § 103. At that time, claims 6-7, 15-16, and 24-25 were rejected based on McDonough under section 103. A rejection based on section 101 was also issued.

After an amendment directed to address the section 101 issue and to further recite additional features of the invention, the entire application, including claims 1-27 was allowed.

The issue fee was paid and the application was ready for issuance. Then, based on a communication with the Examiner, the undersigned was informed that the application was pulled from allowance by quality review. A new Office Action was issued rejecting all of the claims, including 6-7, 15-16 and 24-25 under section 102(e) over McDonough.

This is a case that applicants believe should be taken to the Board of Patent Appeals and Interferences. The inconsistent positions taken during examination leave applications without any understanding of the PTO's stance. To date, applicants have already paid an issue fee and waited over nine months before learning that the application would not issue. The delay in filing this appeal was due in large part to applicants not understanding the PTO's position and how to respond.

For example, claims 6-7, 15-16 and 24-25 have been rejected under section 103 based on McDonough, then allowed over McDonough and now rejected under section 102(e) over McDonough despite the fact that they have *never been amended* other than to state that they are "computer implemented methods."

As set forth in greater detail in applicants' Response dated January 20, 2004, McDonough simply fails to disclose each and every feature of the claims as present recited. McDonough is not directed to providing reports including performance operations of a business intelligence system as that phrase has been defined in the above-referenced application. Moreover, as the Examiner acknowledged early in prosecution of this case, McDonough fails to "explicitly address[]" the elements recited in dependent claims 6-7, 15-16 and 24-25. See Office Action of August 18, 2003 at pages 5-6. Applicants agree that McDonough does not "explicitly address" these elements. The more recent Office Action's contention that these elements are addressed "in some guise" is wrong and inconsistent with early statements by the PTO.

For these reasons, applicants request an appeal conference be convened to advise applicants whether the Office will 1) allow the present claims, 2) reopen prosecution and issue a new office action or 3) allow this case to proceed to appeal.

Respectfully submitted,



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